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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,104	02/25/2004	Teruhiko Tsuji	042125	8813

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EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/785,104

Applicant(s)

TSUJI, TERUHIKO

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al. 3,271,888 in view of Criswell 3,040,455. Graham et al. '888 discloses all the limitations substantially as claimed including the following: a protecting tool 10 for a shoe; the tool comprising an overshoe type attaching member 32, 42 which is put on over a footwear in a state of wearing the footwear; a protecting member 24 having rigidity and attached to the overshoe type attaching member so as to cover at least an instep portion (see Figure 1); the protecting member comprises a curved portion (covers metatarsals of the user's foot in the instep area) which is curved along at least a shape of the instep portion of the overshoe type attaching member and is spaced from the instep portion of the overshoe type attaching member (see Figure 4, side instep portion just above where 32 is attached to 24); a leg portion 82 which comes into contact with the ground when the curved portion receives impact so that the curved portion is prevented from moving toward the instep portion of the overshoe type attaching member (see col. 3, lines 8-14); the overshoe type attaching member comprises holding means 32, 42 for holding the protecting member such that a lower end edge of the leg portion is located above the ground-contact surface except a case in which the protecting member receives an impact (see Figures 1 and 3); the holding means includes an engaging portion 34 provided between the

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overshoe type attaching member and the protecting member; the engaging portion comprises a first engaging portion formed in front portions of the overshoe type attaching member and the protecting member (holes for portions 34) and a second engaging portion 34 formed in rear portion of the overshoe type attaching member and the protecting member and turnably engaging with the protecting member (rotates with respect to strap, see Figures 1 and 3); the first engaging portion comprises a holding projection (rivet 34) provided on one of the overshoe type attaching member and the protecting member; a portion (hole for rivet) to be engaged provided on the other one of the over shoe type attaching member and the protecting member; the second engaging portion comprises a holding shaft (rivet) provided on one of the overshoe type attaching member and the protecting member; a mounting hole (hole for rivet 34 to pass through) on the other one of the overshoe type attaching member and protecting member; the overshoe type attaching member comprises an attachment bottom 50 which supports a bottom of the footwear and an attaching member body 60 which is made of resiliently deformable material and which urges the footwear so as to fix the footwear on the attachment; the protecting member is laterally symmetric with respect to a center in the widthwise direction thereof (see Figure 1).

Graham et al. '888 does not teach the protective member attached to the overshoe type attaching member so as to cover at least an instep portion of the overshoe type attaching member. Criswell '455 teaches that an overshoe type attaching member 4 can be covered by a protective member 2 in the instep area of the shoe (see Figures 1 and 3) so as to protect the attaching member from tearing at the attachment point of the attaching member to the protector. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place

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the attachment area underneath the protective member to protect the connection from being frayed and failing due to external impacts.

3. Claims 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied above in view of Griswold 4,231,170. The references as applied above disclose all the limitations of the claims except for the protecting member being made of synthetic resin. Griswold '170 teaches that synthetic resin can be used to form a protector for a user's foot to aid in protecting the user's foot from impact. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the protector of the references as applied above out of synthetic resin to make it light in weight, durable, strong and resilient to rebound back after impact and after protecting the user's foot from the impact.

#### *Response to Arguments*

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The arguments with respect to the Graham et al. reference and Official Notice are addressed in the rejections set forth above.

#### *Conclusion*

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

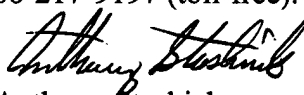
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS